Remarks/Arguments:

Claims 1-4 and 6-7 stand rejected under 35 U.S.C. 102 as being anticipated by U.S. Patent No. 4,295,235 to Dietz. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietz. Claims 9, 10, and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dietz in view of U.S. Patent No. 4,996,100 to Druckman et al. Claims 9, 11, and 12 stand rejected as being unpatentable over Dietz in view of U.S. Patent No. 6,557,590 to Swers et al.

The Examiner's Rejections Under 35 U.S.C. 102(b) Should Be Withdrawn

Both the Patent Office and the CAFC (formerly the CCPA) have historically required that a single reference teach each and every element of the claim. That requirement is clear and unequivocal. Atlas Powder v. I.E. DuPont, 750 F.2d 1569, 224 USPQ 409 (CAFC 1984). James Bury Corp. v. Litton Industrial Products, 750 F.2d 1556, 225 USPQ 253 (CAFC 1985).

Claims 1-4, 6, and 7 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,295,235 to Dietz.

Applicant's invention is directed to a multi-layer roofing material for convertible tops. The outer layer is formed of at least about 25% polymeric coated yarns. The inner lining, or headliner, is formed of non-coated conventional yarns such as cotton, polyester, or a combination thereof. The roofing fabric construction is completed by connecting the inner and outer layers with an adhesive waterproofing layer. More specifically, as amended, Claim 1 requires that the adhesive waterproofing layer bond the entire surfaces of the outer layer and inner layer together.

Dietz is directed to a cushion construction that attempts to address the problem of waterproofing or easily drying outdoor seat cushions after exposure to moisture or rain. The cushion is formed of a pair of opposed woven side layers (12,14) and an interlayer (32) of water impervious material. The interlayer (32) is not bonded to the entire surface of the adjacent side layer (12). See Figures 6,7. A fiber batting filler material (18) is positioned between the water impervious interlayer (32) and the bottom side layer (14). The interlayer (32) is attached along peripheral edge portions only to the peripheral edge portions only of the opposed side layers.

The construction is completed by the application of a heat seal (38) that melts and fuses the side layers and interlayer around the periphery only.

First, Applicant's claimed roofing material, as amended, requires that the adhesive waterproofing layer bond the entire surface of the outer layer substantially to the layer of the inner layer. That is, rubber or thermoplastic olefin (TPO or TPE) is extrusion coated or spread coated onto the underside of the outer layer. The inner layer is then applied, and the three-layer construction is fed through pressure rollers as the adhesive layer dries. In stark contrast, the interlayer of the Dietz cushion is heat sealed only around the periphery of the cushion, and not across the entire surfaces of the side layers.

Further, the interlayer disclosed by Dietz is not an adhesive layer, nor does it bond the surface of the inner layer to the surface of the outer layer. The Examiner cannot simply overlook this limitation of the claimed invention. Whereas Applicant's waterproofing layer is an adhesive layer comprises rubber or thermoplastic olefins, Dietz discloses the interlayer as a self-supporting film of vinyl material that may be any sheet material which is water impervious and of suitable thickness.

Thus, lacking an adhesive waterproofing layer, and lacking a construction wherein the side layers are bonding across their surfaces, Dietz cannot be a basis for a proper rejection under 35 U.S.C. 102(b). The Examiner's rejections must, therefore, be withdrawn.

The Examiner's Rejections Under 35 U.S.C. 103(a) Should Be Withdrawn

The CAFC (and the CCPA before it) have repeatedly held that, absent a teaching or suggestion in the primary reference for the need, arbitrary modifying of a primary reference or combining of references is improper. The ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577. 221 USPQ 929, 933 (Fed. Cir. 1984). In re Gieger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietz. Claims 9-10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto (U.S. Patent No. 6,539,898) in view of U.S. Patent No. 4,996,100 to Druckman et al. Claims 9 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto in view of U.S. Patent No. 6,557,590 to Swers et al.

Regarding Claims 5 and 8, the Examiner finds no teaching or suggestion in the references for Applicant's claimed ranges of denier, asserting instead the unsupported conclusion that the claimed ranges are but result effective variables. Applicant respectfully diagrees. This is analogous to the range of deniers being "an obvious matter of design choice," which the Board of Patent Appeals and Interferences has held to be an "unsupported conclusion—not a reason upon which to base the rejection." In re Garrett, 33 BNA PTCJ 43 (November 13, 1986). Therefore, the Examiner's rejections of Claims 5 and 8 must either be supported, or withdrawn. Regardless, having overcome the Examiner's rejections of independent Claim 1, the rejections of all dependent claims should fall.

Regarding Claims 9, 10, and 13, the Examiner now attempts to reject these same dependent claims under another improper combination. Again, Dietz is directed to the problem of waterproofing and drying. Nowhere does Dietz recognize, nor should he, the problem of soft or hard fabric materials. Rather, Dietz discloses a single woven fabric construction for both of the opposed side layers. Druckman et al. discloses a fabric having a vinyl component, which Druckman et al. refers to as "hard" yarn, combined with "soft" yarns which may be polyester, polypropylene, acrylics, modacrylics, etc. Additionally, Druckman et al. does not even disclose a coated yarn. Applicant respectfully submits that the Examiner has attempted to piece together the features and aspects of Applicant's construction from two unrelated pieces of prior art. The Federal Circuit has stated that:

> Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. * * * Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.

In re Dembiczak, 50 USPQ2d 1614, 1617.

The Federal Circuit has also stated that:

> It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot

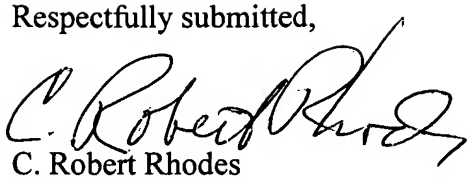
> use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.
>
> In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).

Applicant, thus, respectfully requests that the Examiner withdraw her rejections of Claims 9, 10, and 13 under 35 U.S.C. 103(a).

Lastly, the Examiner attempts to again reject Claims 9, 11, and 12 under another improper combination. The Examiner relies on Swers et al. only to show the "effect" yarns that are included in Applicant's fabric construction, yet the uses of "effect" yarns in fabric production are specific to the yarn materials, fabric construction, and desired results. In short, the term "effect" as applied to yarns is virtually meaningless unless it is defined in terms of a particular use. The real heart of the Swers et al. teaching is a woven structure of warp and fill yarns in which at least some of the fill yarns are self-coating composite yarns formed of high melt and low melt yarn constituents. Upon heating in a tentering operation, the low melt constituents melt, cross-flow to the high melt yarns, and bond the warp and fill yarns at the intersections to achieve fabric stability. The Examiner has simply not suggested how this low melt/high melt bonded construction has any applicability or could be combined with Dietz, or why anyone of ordinary skill in the art would have been motivated to modify the simple woven fabric construction for the waterproofed cushion of Dietz with the bonded construction of Swers et al. Nowhere in Dietz's specification is there any suggestion of a problem that would be satisfied, or a waterproof cushion construction that could be improved by a fabric such as that disclosed in Swers et al. Applicant, thus, respectfully requests that the Examiner withdraw her rejection of Claims 9, 11, and 13 under 35 U.S.C. 103(a).

The Applicants believe that the Examiner's rejections have been successfully overcome, and that the application has been placed in condition for immediate allowance with Claims 1-13. Such action is respectfully requested. However, if any issue remains unresolved, Applicants' attorney would welcome the opportunity for a telephone interview to expedite allowance and issue.

Respectfully submitted,



C. Robert Rhodes
Registration No. 24,200
Lewis S. Rowell
Registration No. 45,469
Womble Carlyle Sandridge & Rice, PLLC
300 North Greene Street
1900 First Union Tower
Greensboro, NC 27401
336-574-8040

Date: 8-19-04